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OFFICE OF PETITIONS

In re Patent of Chen :
Patent No. 7,202,259 :
Issue Date: April 10, 2007 :
Application No. 10/714,066 : ON PETITION
Filed: November 11, 2003 :
Attorney Docket No. 085742-0496 :
Title: THERAPEUTIC AGENTS USEFUL :
FOR TREATING PAIN :
:

This is a decision on the PETITION UNDER 37 C.F.R. 1.183, the PETITION UNDER 37 CFR 1.181, the PETITION UNDER 37 CFR 1.182, and the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705. All of the aforementioned petitions were filed on July 22, 2010. In addition, this decision addresses the REQUEST FOR CERTIFICATE OF CORRECTION, filed August 23, 2010.

Patentee requests that the requirements of 37 CFR § 1.705(d) be waived to permit reconsideration of the patent term adjustment in the above-identified patent more than two months after the issuance of the patent. Alternatively, patentee requests that the requirements of the *Interim Procedure for Patentees to Request a Recalculation of the Patent Term Adjustment to Comply with the Federal Circuit Decision in Wyeth v. Kappos Regarding Overlapping Delay Provisions of 35 U.S.C. §154(b)(2)(A)* be waived to permit the reconsideration of the patent term adjustment of the above-identified patent later than 180 days after its issuance.

Patentee requests that the revised patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by four hundred ninety-eight (498) days. Patentee requests this correction on the basis that the Office took in excess of three years to issue the patent and in light of the Court of Appeals for the Federal Circuit's decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

The petitions under 37 CFR 1.183, 1.182, and 1.181 are hereby **dismissed**.

The request for reconsideration of patent term adjustment under 37 CFR 1.705(d) is **dismissed as untimely filed**.

The request for certificate of correction is **dismissed**.

37 CFR 1.705(d) provides that:

If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section.

On February 1, 2010, the USPTO published a Federal Register notice that, *inter alia*, announced a limited waiver of the two-month deadline for filing a petition for reconsideration of a PTA determination under 37 CFR § 1.705(d). See *Interim Procedure for Patentees to Request a Recalculation of the Patent Term Adjustment to Comply with the Federal Circuit Decision in Wyeth v. Kappos Regarding Overlapping Delay Provisions of 35 U.S.C. §154(b)(2)(A)*, 75 Fed. Reg. 5043 (Feb. 1, 2010)(notice).

Specifically, patent owners were permitted to request recalculation of a patent's PTA in view of the Federal Circuit decision *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010) up to 180 days after the grant of the patent. The USPTO determined not to accept any requests for PTA recalculation initially filed more than 180 days after patent grant, however, in view of the statutory judicial-review provisions of 35 U.S.C. § 154(b)(4), which require that any civil action to challenge the USPTO's PTA determination be brought within 180 days of patent grant. The USPTO believes that the statutory 180-day period for seeking court review of the USPTO's PTA determinations, particularly in view of the six-year statute of limitations that otherwise is applicable for actions under the Administrative Procedure Act, indicates a congressional intent that PTA issues be resolved after a patent issues. The USPTO does not consider it likely that Congress created a scheme under which the time period to seek initial USPTO review of a PTA determination extends beyond the time period provided for a dissatisfied patentee to seek judicial review of the USPTO's PTA determination. Thus, the USPTO believes that the 180-day period in 35 U.S.C. § 154(b)(4) represents the outer limit on the USPTO's ability to conclude its PTA determination.

The instant patent issued on April 10, 2007. The instant request for reconsideration of patent term adjustment under 37 CFR 1.705(d) was filed on July 22, 2010, over three years and two months later. As this request was filed more than 180 days after patent grant, it is appropriate to deny the request for waiver.

In view thereof, the time requirement of 37 CFR 1.705(d) is not met. The petition for recalculation/reconsideration of the USPTO's PTA determination for U.S. Patent No. 7,202,259 is dismissed as untimely filed.

Turning to the August 23, 2010 Request for Certificate of Correction: During July 2010, the Office issued a notice in the federal register clarifying when the Office will change the patent term adjustment for a patent via issuance of a certificate of correction.¹ The Notice states,

The USPTO ... has determined that it is not appropriate to provide a patent term adjustment recalculation via a certificate of correction under 35 U.S.C. 254 or 255. A certificate of correction is permissible under 35 U.S.C. 254 only for a mistake in a patent that “is clearly disclosed by the records of the Office.” *See* 35 U.S.C. 254. While the applicable patent term adjustment is ascertainable from the records of the USPTO, a revised patent term adjustment determination requires a complex calculation that is not “clearly disclosed” by the records of the USPTO. In addition, a certificate of correction is permissible under 35 U.S.C. 255 only for “a mistake of a clerical or typographical nature, or of minor character.” *See* 35 U.S.C. 255.

Thus, the USPTO has long maintained that a request for a certificate of correction under either 35 U.S.C. 254 or 255 is not an appropriate venue for seeking a change to the patent term adjustment indicated on the patent....

[I]t is not appropriate to issue a certificate of correction under 35 U.S.C. 254 or 255 to revise the patent term adjustment indicated in the patent unless it is being revised for consistency with: (1) The patent term adjustment determined via a decision on a request for reconsideration under 37 CFR 1.705; or (2) the total patent term adjustment indicated on the Patent Application Information Retrieval (PAIR) screen that displays the patent term adjustment for the patent....

[T]he USPTO will not grant a request for a certificate of correction ... to revise the patent term adjustment indicated in the patent, except in the two situations discussed previously.²

Even if the number of days of patent term adjustment on a requested certificate of correction is less than the number of days listed on a patent, a certificate of correction will not be issued unless one of the previously identified exceptions exist. As stated by the Office, with emphasis added,

If the applicant or patentee wants the USPTO to reconsider its patent term adjustment determination, the applicant must use the procedures set forth in 37 CFR 1.705 for requesting reconsideration of the patent term adjustment determination, whether the USPTO’s patent term adjustment determination is greater or less than the adjustment that the applicant believes to be appropriate.³

¹ *Treatment of Letters Stating That the USPTO’s Patent Term Adjustment Determination is Greater Than What the Applicant or Patentee Believes is Appropriate*, 75 Fed. Reg. 42079 (July 20, 2010).

² *Id.* at 42079-42080.

³ *Id.* at 42080.

Neither of the two exceptions discussed in the previously quoted language apply in this case. Therefore, the request for a certificate of correction listing a patent term adjustment of 498 days is dismissed.

Receipt of the \$400 fee required for consideration of the petition under 37 CFR 1.183 is acknowledged. Receipt of the \$400.00 fee required for consideration of the petition under 37 CFR 1.182 is acknowledged. Receipt of the \$200 fee for consideration of the request for reconsideration of patent term adjustment is acknowledged. Receipt of the \$130.00 processing fee of the requested certificate of correction is acknowledged.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3230.



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